



UNITED STATES PATENT AND TRADEMARK OFFICE

ca
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/628,464

07/29/2003

Jon Elliot Adler

4703

21967 7590 10/22/2007
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

HOWARD, ZACHARY C

ART UNIT	PAPER NUMBER
----------	--------------

1646

MAIL DATE	DELIVERY MODE
-----------	---------------

10/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/628,464

Applicant(s)

ADLER ET AL.

Examiner

Zachary C. Howard

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☒ Newly proposed or amended claim(s) 118-123 and 128-141 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 118-123 and 128-141.
Claim(s) objected to: 125-127.
Claim(s) rejected: 124.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Elizabeth C. Kemmerer/
Primary Examiner, Art Unit 1646

Continuation of 5. Applicant's reply has overcome the following rejection(s):

The following page numbers refer to the 7/8/2007 Office Action.

The objections to claims 118, 120 and 124 at pg 3 is withdrawn in view of Applicants' amendments to the claims.

The rejection of claims 130-132 and 134-141 at pg 3-4 under 35 USC 112, first paragraph for lack of enablement for the full scope of the claims is withdrawn in view of Applicants' amendments that limit claims to "isolated recombinant host cells".

The rejection of claims 118-141 at pg 5-6 under 35 USC 112, second paragraph, as being indefinite is withdrawn in view of Applicants' amendments to claims 118, 119 and 124.

The rejection of claims 118-123 at pg 6-7 under 35 U.S.C. 102(a) as being anticipated by NCBI Entrez Nucleotide, database record for Locus AC092214 (Version AC09914.2, 15 September 2001) is withdrawn in view of Applicants' amendments to claim 118.

Continuation of 11. does NOT place the application in condition for allowance because:

Claim 124 is objected to because of the following informalities: the end of part (i) of claim 124 is missing a semi-colon (as is used at the end of part (ii)). Appropriate correction is required.

Claims 124 is rejected under 35 USC 102(a) as being anticipated by NCBI Entrez Nucleotide, database record for Locus AC092214, Version AC092214.2, 15 September 2001, 60 pages. The earliest date to which the instant application claims priority is July 29th, 2002. This rejection was set forth previously and made final at page 6-7 of Office Action mailed 7/18/07.

Applicants' arguments (9/19/07; pg 7-8) as they pertain to the rejection have been fully considered but are not deemed to be persuasive for the following reasons. In the response, Applicants state the rejection of claims 118-124 under 35 USC 102(a) is overcome as claim 118 has been amended to change "operably" to "operatively" (pg 8).

Applicants' arguments have been fully considered but are not found persuasive. Claim 124 is an independent claim that does not depend from claim 118. Therefore, the rejection of claim 124 is not subject to amendments to claim 118. Applicants have also amended claim 124; however, these amendments simply correct typographical errors and do not change the scope of the claim. Therefore, it is maintained that AC092214.2 anticipates claim 124 for the reasons set forth previously. The record for AC092214.2 describes a RP11-811J9 clone that is a bacterially artificial chromosome (BAC) comprising a human chromosomal sequence that between residues 157151-158107 contains a nucleic acid sequence that encodes a protein that is 100% identical to SEQ ID NO: 2. Furthermore, a BAC containing one or more mammalian genes (each comprising their native promoters) is inherently capable of expression in mammalian cells. For example, Baker et al (1997. Nucleic Acids Research. 25(10): 1950-1956; cited previously to support inherency) teaches a "method of introducing BACs into eukaryotic cells using BAC DNA" (pg 1956) and expression of a human gene located in a BAC. The record for AC092214.2 contains over 155,000 residues upstream of the sequence encoding SEQ ID NO: 2; this upstream region contains the promoter for expression of the human T2R76 gene. As such, the record for AC092214.2 teaches an expression vector that is capable of providing for the expression of a T2R polypeptide of SEQ ID NO: 2 in a recombinant host cell. This expression vector is encompassed by claim 124 and therefore anticipates the claim.

Claims 125-127 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Claim 127 is also objected to for misspelling "expression" as "expresssion". Appropriate correction is required.